

Application No. 09/916,053
Amendment Dated August 13, 2003
Reply to Final Office Action of February 13, 2003

REMARKS

In the Final Office Action mailed from the United States Patent and Trademark Office on February 13, 2003, the Examiner rejected all of the pending claims "under 35 U.S.C. §112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention." Applicant respectfully disagrees with the Examiner's position.

Contrary to the Examiner's position, the application as filed clearly described applicant's invention to a person skilled in the art. The amendment presented to the specification was simply an amendment to correct the scope of the prior art, not to modify applicant's description of the invention. Applicant's invention is exactly as originally stated in the application, including the claims.

Applicant submits that the application clearly shows that applicant was in possession of the claimed invention as of the filing date of the application, and that the amendment submitted to correct the scope of the prior art does not in any way change that fact. The fact that the actual prior art is more remote from applicant's invention than was previously believed to be the case may have relevance to the issue of patentability of the invention, but not to the fact that applicant actually was in possession of the invention as of the filing date.

In Ex Parte Clark A. Anderson, et al., Appeal No. 95-2910 (copy attached), the Board clearly stated that the purpose of the written description requirement "is to ensure that the applicants convey

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with reasonable clarity to those skilled in the art that they were in possession of the invention as of the filing date of the application.” (See page 2 of Opinion).

The Federal Circuit has made it clear that for the purposes of the written description requirement, the invention is “whatever is now claimed.” Vas-Cath, Inc. v. Mahurkar, 935 F.2d 1555, 1564, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991).

It is clear that the claims presented in this Amendment set forth the invention that clearly was described in the application as originally filed. In particular, the amendments to the claims specifying that the antistatic agent in the slip layer is present in a sufficient amount to preclude the migratory amide in the core from migrating to the surface of the skin layer in an amount which would adversely affect the adhesion of the adhesive employed on the formed label for the slip layer, is clearly described and supported by the paragraph beginning on line 10 of page 4, and in particular, by the sentence beginning on line 17, as follows:

“In order to achieve these COF and adhesion properties [the specific adhesion values being specified in the preceding sentence] the additive in the skin layer needs to be of a type that provides the desired slip properties without undesirably affecting adhesion properties and needs to be present in an amount to preclude the migratory amide in the core from migrating to the surface of the skin layer in an amount that impairs the adhesion properties at that surface.” (emphasis added)

The numerical limits of the desired adhesion properties are set forth in the first sentence of the paragraph beginning on line 10 of page 4.

The amendment relating to the scope of the prior art has absolutely no bearing on the issue of applicant’s possession of the invention as of the filing date of this application.

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If the Examiner persists in this rejection, Applicant respectfully requests that the Examiner present evidence or reasons why persons skilled in the art would not recognize in the disclosure a description of the invention defined by the claims. This clearly is the initial burden of the Examiner (see page 2 of attached opinion re: Ex Parte Clark A. Anderson, et al.).

In the Final Office Action, the Examiner also rejected claims 1, 3 - 6, 8 - 28, 30 - 33 and 35 - 50 "under 35 U.S.C. §103 (a) as being unpatentable over applicant's newly amended admissions concerning the prior art ... in view of Frognet et al. ..." Applicant submits that this rejection cannot be sustained, either with respect to the claims that were finally rejected or the claims as amended herein.

Specifically, the prior art acknowledged by applicant on page 3 of the application is that although antistatic additives and migratory amides have been employed in the same multilayer film, they have not been employed in separate layers for the purposes required in the present invention. Frognet et al. does not overcome this deficiency.

The film of the present invention has a two-fold benefit that is achieved by the claimed structure. First, both the migratory amide in the core layer and the antistatic agent in the siip layer are present "in amounts to provide a COF on the surface of the slip layer of no greater than 0.45." Second, the antistatic agent and the amide need to be present in amounts to provide an adhesion of the adhesive employed on the formed label for the slip layer of at least 50%.

Clearly, neither the acknowledged prior art by applicant nor the Frognet patent relate in any way to structures for achieving these two desired benefits of coefficient of friction and adhesion.

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Applicant submits that the Frognet et al. patent does not cure the defect existing in the prior art acknowledged by applicant. In fact, the Examiner appears to acknowledge that neither the present admission relating to the state of the prior art nor Frognet et al. disclose a multilayer structure wherein a migratory slip agent is provided in the core layer and an antistatic agent is provided in an outer slip layer. Rather, it appears that the Examiner is taking the position that regardless in which layer or layers the migratory amide and antistatic agent are included, they will tend to migrate to the surface to reduce COF. What is missing from the combined teaching, and also from the Examiner's analysis is that there is absolutely no teaching of a biaxially oriented multilayer film wherein the migratory amide and the antistatic agent are judiciously placed in different layers to achieve two required benefits; namely, a desired coefficient of friction on the surface of the slip layer of no greater than 0.45 and an adhesion of the adhesive employed on the formed label for the slip layer of at least 50%.

The Examiner's analysis attempting to support the final rejection of the claims completely ignores the adhesion limitation set forth in the claims, and the requirement that the migratory amide be in the core layer and the antistatic agent be in the slip layer to achieve this desired benefit.

In particular, independent claims 1 and 28 now clearly specify that the antistatic agent, which is in the slip layer "[is] present in a sufficient amount to preclude the migratory amide in the core layer from migrating to the surface of the skin layer in an amount that reduces the adhesion of the adhesive employed on the formed label for the slip layer to less than 50%." This amendment is clearly supported by the paragraph beginning on line 10 of page 4 of the application, as filed.

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Clearly neither the admitted state of the prior art nor Frognet et al. disclose this latter combination.

All of the remaining claims in this application are either directly or indirectly dependent upon claims 1 and 28, and therefore are submitted to be patentable for at least the reasons discussed above with respect to claims 1 and 28. In addition, a number of these dependent claims set forth various other features which are neither shown nor suggested in the prior art of record.

For at least the reasons set forth above, it is respectfully submitted that the above-identified application is in condition for allowance. Favorable reconsideration and prompt allowance of the claims are respectfully requested.

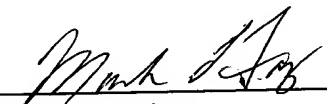
Should the Examiner believe that anything further is desirable in order to place the application in even better condition for allowance, the Examiner is invited to contact Applicant's undersigned attorney at the telephone number listed below.

Respectfully submitted,

CAESAR, RIVISE, BERNSTEIN,
COHEN & POKOTILOW, LTD.

August 13, 2003

Please charge or credit our Account
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entry and/or ensure consideration of
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